

NO. 21415 ✓

IN THE  
UNITED STATES COURT OF APPEALS  
FOR THE NINTH CIRCUIT

JUN 19 1968

JACK BAROFSKY,

Appellant,

*See Vol.  
3397*

vs.

GENERAL ELECTRIC CORPORATION,

Appellee.

Appeal from the United States District Court  
for the Central District of California

PETITION FOR RECONSIDERATION

(Including Suggestion for Re-Hearing  
by the Court en banc)

FILED

JUN 18 1968

WM. B. LUCK, CLERK

SMYTH, ROSTON & PAVITT,  
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JUN 18 1968



Petitioner (appellant) respectfully submits that the opinion of his Honor, Judge Hamley, for the majority of the Court, reveals that the majority has failed "to see the forest for the trees" in discussing what it conceives to be the several individual and dominant features of petitioner's patented design, namely, the length, width and depth of the doors, the use of sound permeable fabric (grille cloth), the presence of bevels and the hinging of the doors. The opinion then, in effect, concludes as a matter of law that all of these features primarily serve a functional purpose so that the design patent is invalid.

What the majority opinion appears to overlook entirely, however, is that the principal and dominant feature of the patented design does not lie in the details of construction of the doors thus discussed in its opinion, but rather in the symmetrical and pleasing appearance resulting from disposing, on the leading vertical edges of a central electronic unit, such as a television set, in hinged relationship thereto, a pair of matching speaker doors, one on each side of the central unit. This is the feature which appellee, commencing some eight years after the Barofsky patent-in-suit was applied for, has so consistently stressed in its advertising of its embodiments of this basic design idea, as being "revolutionary", "unique", etc. (See: Plaintiff's First Request for Admissions, Exh. 6, R. 70-120; Barofsky dep. Exhs. C(1)-(34); 13; R. 245). This symmetry was what appellee stressed before the Patent Office in successfully urging allowability of its design patent



application on such embodiment. (See: Defendant's arguments before United States Patent Office contained in file wrapper of defendant's Bentzen patent, D-70,374, included in Supplemental Submission before District Court, R. 387,393-394, 436-439).

The question which should have been considered by the Court is whether on the record presented there was any genuine issue concerning the material fact of whether this principal and dominant feature of the patented design was primarily to serve a functional purpose. Petitioner submits that both the Barofsky depositions\* and the Kelso affidavit plainly and unequivocally place this material fact in issue. Thus, Kelso states that at the time petitioner made his invention in 1953, there was no home stereo on the market on a commercial basis, and there was no functional requirement for two separated speakers housed in hinged doors (Kelso affidavit, paragraphs 13, 14 and 15 (R. 300-301)). While the doors shown in the patent drawing were admittedly intended to be speaker housings, petitioner stated, in effect, that he knew nothing of electronics or one wire from another (Barofsky dep. p. 85); nor did he even show any wire connections between the central unit and the doors (Barofsky dep. p. 67). Further, in the design as he

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\* The Barofsky deposition was submitted by appellee in support of its motion for summary judgment before the District Court and was not introduced by petitioner as the majority opinion indicates on page 7.



showed it, the housings were too shallow to accommodate speakers then available in the state of the art (Barofsky dep. p. 74). In arriving at his design, petitioner said it came to him in a flash; he simply had a beautiful vision (Barofsky dep. pp. 68, 81, 85), and attempted to come up with a design which was beautiful (Barofsky dep. p. 75). He unequivocally stated: "\* \* \* The primary purpose of my doors was appearances, commercially attractive appearances." (Barofsky dep. p. 68).

These factual statements are clearly contradictory to, and inconsistent with, any assertion that the symmetry and pleasing appearance of the double speaker housings attached to the central cabinet were primarily to serve any functional purpose. When the electronic art subsequently developed shallow speakers which could fit in speaker doors, as shown in the patent drawing, and home stereo which rendered it desirable to have detachable hinged speakers to give better stereo effect, petitioner's design was found to be adaptable to fulfill such functional purposes; but the portions of the Barofsky deposition and Kelso affidavit cited above clearly place in issue the allegation that the symmetrical design as well as all other features were dictated primarily by functional requirements.

In this state of the record, petitioner submits that the majority of the Court committed a serious and most prejudicial error in disregarding all such evidence so raising a







genuine issue of material fact. Such disregard appears to be consummated on page 7 of the majority opinion by erroneously equating Barofsky's failure to deny that each of the features of his design also serves a functional purpose and the fact that the other exhibits fail to refute "the functional purposes attributable to the dominant features of the design as disclosed by the patent drawing", with an admission that the primary purposes of all of the design features were functional and not ornamental. Petitioner submits that this constitutes a misinterpretation of the evidence of record.

What is especially disturbing to petitioner's counsel about the majority opinion is that the particular point upon the basis of which the majority has thus affirmed the summary judgment of the District Court was one which was only incidentally discussed in petitioner's main brief and not really discussed at all in oral argument before this Court. Appellee's brief did not clearly negate the existence of the issue of fact mentioned above, but on the contrary, on page 22, implicitly acknowledged the existence of the issue of fact as to whether the features of the design were primarily for functional purposes. Consequently, petitioner had nothing in this area to answer in its reply brief. In this connection, it is particularly significant that before the District Court appellee was apparently so dubious concerning whether a genuine issue was presented as to that material fact by petitioner's specification thereof (R. 289), that appellee offered to delete defense



(c) of its Motion for Summary Judgment and §§ 7 and 9 of its memorandum "if the Court feels that there is any question of fact raised thereby". (R. 351).

The principal points orally argued, according to petitioner's counsel's notes, were non-obviousness under §103 of Title 35 and whether the design was pleasing enough to the eye to be ornamental in any sense.

Thus, the design patent procured by petitioner, an individual inventor, without the aid of patent counsel, has not only been destroyed summarily without his having had his day in Court, but such summary destruction has been affirmed by the majority of this Court on a ground which was never really argued in the briefs or orally before this Court. Petitioner respectfully submits that this result is most inequitable and unjust.

Petitioner suggests that in the circumstances and because of the importance to patentees of views of this Court respecting the granting of summary judgments, rehearing be granted before the Court sitting en banc.

DATED: June 10, 1968.

SMYTH, ROSTON & PAVITT,  
WILLIAM H. PAVITT, JR.,  
CHARLES H. SCHWARTZ

By

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William H. Pavitt, Jr.  
Attorneys for Petitioner (Appellant).



CERTIFICATE

I certify that, in connection with the preparation of this Petition, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing Petition is in full compliance with those rules.

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William H. Pavitt, Jr.



CERTIFICATE OF SERVICE

I hereby certify that the attached PETITION FOR RECONSIDERATION was this day served upon counsel for Appellee by mailing, postage prepaid, copies thereof to said counsel at the offices of said counsel, Harris, Kiech, Russell & Kern, 417 South Hill Street, Suite 900, Los Angeles, California 90013.

DATED: June 12, 1968

William H. Pavitt, Jr.



